

Remarks

I. Introduction

This is in response to the final Office Action dated November 2, 2005. This response is being filed concurrently with a Request for Continued Prosecution under 37 C.F.R. 1.114. The Office Action rejected claim 1 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action rejected all pending claims under 35 U.S.C. §103(a) based on various combinations of cited art. The particular rejections will be discussed in further detail below. Applicants traverse the rejections.

Claims 8, 9, 19, 20, 32, 33, 37-40, 43-47, 53 and 61-64 have been previously cancelled. Claims 1-7, 10-18, 21-31, 34-36, 41, 42, 48-52 and 54-60 remain for consideration.

II. Information Disclosure Statement

Applicants filed an Information Disclosure Statement (IDS) on August 12, 2005. Applicants request that the Examiner return an initialed copy of the two PTO/SB/08 pages that were submitted as part of that IDS to acknowledge that the references cited therein were considered during the prosecution of the application.

III. Rejection under 35 U.S.C. §112

The Office Action rejected claim 1 (and all claims dependent upon claim 1) under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action indicated that “[i]t is unclear as to how the advertising software and the browser are adapted to function independently, and if the advertising software functions independently of the browser, then how it is possible that a link loads and displays a page in a second region by the browser?”

Applicants note that during a telephone interview on September 1, 2004 the undersigned Attorney discussed this issue with the Examiner. Also, in a subsequent Office Action, the Examiner objected to claim 1 on the same grounds (i.e., that the independent operation of the browser and the advertising software was unclear). In that Office Action, the Examiner indicated that he was interpreting this limitation to mean that the two applications are displayed separately on the screen. In response to that rejection, Applicants amended claim 1 in an Amendment dated January 13, 2005. In particular, in that earlier amendment, Applicants amended claim 1 to recite “said advertising software and said browser adapted to function independently of each other ~~said browser~~ on said client computer by displaying information in different regions of said display device”. In response to this amendment, the Examiner apparently withdrew the claim objection because the next substantive Office Action (dated April 18, 2005) did not have any claim rejection based on this claim limitation. However now, after an earlier objection, an amendment and explanation, and withdrawal of the objection, the Examiner is again rejecting the claim under the same grounds. Applicants are unclear as to the basis for the return of this claim rejection. Claim 1 contains the limitation that the advertising software and the browser are adapted to function independently of each other “by displaying information in different regions of said display device”. This language is clear and unambiguous. If the Examiner persists in this rejection, Applicants request that the Examiner explain in detail which portion of independent function “by displaying information in different regions of said display device” is unclear.

III. Rejection under 35 U.S.C. §103

The present invention is directed to a system and method for advertising and carrying out electronic commerce on the Web. The present invention takes advantage of advertising software that operates as an overlay to a conventional known browser, and divides the user’s client computer display into an advertising area and a browser area. This configuration of software elements allows for certain advantages over the prior art. Such advantages, which are the subject of the claims, are not shown nor suggested in the cited art. As such, allowance of all pending claims is respectfully requested. There are at least two independent bases for allowance of the claims over the cited art as follows.

A. The Cited Art Does Not Teach Displaying Advertising Information in the Browser when the User Selects a Link in the Advertising Area.

One advantage of the present invention is the ability to display further advertising information in the browser area when the user selects a link in the advertising area. As such, the selection of a link in the advertising area of the display causes information to be displayed in the browser area of the display. Thus, if a user, upon viewing an advertisement, wishes to see additional information about a product or service, the user may select a link and cause such additional information to be displayed in the browser area. This aspect of the invention is clearly claimed in all independent claims as follows:

Claim 1:

wherein an advertisement displayed to the user by said advertising software in said first region of said display device comprises at least one link that loads and displays a page in said second region of said display device by said browser when said link is selected by a user.

Claim 13:

wherein an advertisement displayed by said advertising software in said advertising area comprises at least one link that loads and displays a page in a browser area when said link is selected by the user;

Claims 22, 35 and 41:

f. displaying an advertisement page in the browser area when the advertisement shown in the advertising area is selected by a user.

Claim 48:

wherein said browser software and advertising software is further adapted to display an advertisement page by the browser in said browser area when an advertisement displayed by said advertising software in said advertising area is selected by the user.

The cited art does not disclose these limitations.

The outstanding Office Action fails to address these limitations, and cites no portion of the cited art that discloses these limitations. As such, the Office Action has failed to make a prima facie showing of obviousness. For this reason, the rejection

under 35 U.S.C. §103 is improper, and withdrawal of the rejection and allowance of the claims is requested. In particular, the Office Action sets forth the basis for rejection of claim 1 at page 3, line 12 – page 4, line 17. The Office Action sets forth the basis for rejection of claim 13 at page 10, line 15 – page 12, line 4. The Office Action sets forth the basis for rejection of claim 22 at page 5, line 6 – page 6 line 8. The Office Action sets forth the basis for rejection of claim 35 at page 7, line 17 – page 8, line 7. The Office Action sets forth the basis for rejection of claim 41 at page 7, lines 1 – 16. The Office Action sets forth the basis for rejection of claim 48 at page 17, line 22 – page 19, line 10. Nowhere, however, does the Office Action address the claim limitations set forth above relating to displaying advertising information in the browser when the user selects a link in the advertising area. If the Examiner persists in this rejection, Applicants requests that the Examiner specifically address this claim limitation.

Notwithstanding the Office Action's failure to address this limitation, Applicants will address this limitation in view of van Hoff et al. Col. 5, lines 1-14 of van Hoff et al. merely indicates that additional information about an advertisement may be retrieved through a URL which is linked to a WWW site. However, in accordance with the disclosure of van Hoff et al., the additional information will be displayed in the advertisement window of the display, not in the browser window as claimed in claim 1. As disclosed by van Hoff et al. at col. 5, lines 1-14, the applets (310) perform the retrieval of the additional information. As described at col. 7, lines 25-30 of van Hoff et al., the applets are methods for displaying the information in the Ad list and the Ad **window** (corresponding to the advertising region of the present invention), as distinguished from the present invention in which the additional information selected by the user is displayed in the **browser region** of the display. The independent claims claim that when a user clicks on an advertisement in the advertisement region of the display, the resulting information is displayed in the browser region of the display. However, in van Hoff et al. the additional retrieved information is displayed in the advertising section, not in the browser region. As such, van Hoff et al. does not disclose these claim limitations, and the independent claims are therefore allowable over the cited art.

B. The Cited Art Does Not Teach Dynamic Targeting Of Advertisements Based On Content Displayed At The User's Browser

Another advantage of the present invention is the dynamic targeting of advertisements to a user's web browser. As described in the specification at page 18, lines 10 – 27 and page 25, line 17 – page 28, line 27, one advantage of the present invention is the ability to target specific advertisements to users based on the browsing habits of the user. In particular, the advertisements are targeted by analyzing the content of the pages displayed in the browser display area and choosing advertisements relating to the content of such pages.

This aspect of the invention is clearly claimed in all independent claims as follows:

Claim 1:

said advertising software adapted to receive an advertisement selected based on an analysis of the content of at least one page displayed to a user by said browser in said second region of said display device.

Claim 13:

wherein said server targets said advertisements to the user, said server selecting advertisements based on an analysis of the content of pages displayed through said browser in said browser area on said client's computer at the user's request.

Claims 22, 35 and 41:

b. analyzing the content of pages viewed through said browser in said browser area on said client computer at the user's request in order to determine the topics of said pages.

Claim 48:

a memory that stores browser software adapted to be executed to retrieve and display in a browser area a hypertext page from a site and advertising software adapted to retrieve and display in an advertising area targeted advertisement from an advertising server which selects advertisements based on an analysis of the content of pages viewed through said browser software in said browser area

The cited art does not disclose these limitations.

The Office Action relies on the newly cited reference “Dialog (Tool May Help Advertisers Target Individuals Dynamo Says it Can Generate Custom Pages Based on Interests)” as disclosing these claim limitations. However, this reference does not disclose the claimed limitations.

As claimed, the analysis is performed on the content of the page displayed to the user in the browser portion of the display. Thus, what is analyzed is the content that is being displayed to, and viewed by, the user at the browser. The cited reference is different. The cited reference is “a server based application” that “tracks where each visitor to a site travels and what the visitor clicks on”. Being a server based application, the cited reference necessarily analyzes what is happening at the server.

The above claim limitations, to the contrary, are directed to analyzing the content that is being displayed in the browser portion of the display at the client computer as further discussed in the specification at page 25, line 17 – page 26, line 20. For example, if the web page is an HTML document (as is often the case) then the content of the web page may be analyzed by an analysis of the words that appear between the TITLE headers in the HTML documents. Thus, the analysis is based upon an analysis of the web page, as displayed to the user in the browser region of the display. The cited reference cannot analyze the web page as displayed to the user in the browser region of the display because the cited reference describes a tracking technique implemented at the server, not at the client computer. Thus, the cite “Dialog” reference does not teach these claim limitations.

All remaining dependent claims depend upon, and incorporate the limitations of, one of the independent claims described above and are allowable for the reasons discussed above. Further, the dependent claims are further allowable due to the additional patentable subject matter claimed therein. For example, claims 4, 14, 27 and 50 are directed to the establishment of interactive communications between a user and a sales agent through the use of the advertising software. Applicants repeat the arguments made with respect to these claims in the prior responses dated September 19, 2003 and January 13, 2005.

IV. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all pending claims is respectfully requested.

Respectfully submitted,



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